THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROLF DHEIN, KNUD REUTER, LOTHAR BACKER, JOACHIM PROBST, WERNER KUBITZA AND RAINER RETTIG

Appeal No. 1997-0334
Application 08/211,698[1]

ON BRIEF

Before METZ, PAK and WALTZ, ***Administrative Patent Judges***.

METZ, ***Administrative Patent Judge***.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's refusal to allow claims 4 and 5, all the claims remaining in the application.

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[1] Application for patent filed April 13, 1994. Filed pursuant to 35 U.S.C. § 371 based on PCT/EP92/02373, filed on October 15, 1992.

THE INVENTION

The appealed invention is directed to a process for producing a urethane coating on a substrate. The process comprises emulsifying the ingredients which make up the urethane in water, applying the emulsified ingredients to the substrate and reacting (curing) the emulsified ingredients to form the urethane coating.

Claim 4 is believed to be adequately representative of the appealed subject matter and is reproduced below for a more facile understanding of the appealed subject matter.

> Claim 4. A process for the production of a polyurethane coating which comprises
>
> A) emulsifying a polyisocyanate component b) having a viscosity at 23EC of 50 to 10,000 mPa·s and containing at least one organic polyisocyanate in an aqueous organic solution or dispersion of a relatively high molecular weight polyol component a) containing a mixture of
>
> a1) a water-dilutable, hydroxyfunctional polycondensation resin free from urethane and sulfonate groups and having a molecular weight Mn above 500 with
>
> a2) a positive amount to 100% by weight, based on the weight of component a1), of at least one water-dilutable, hydroxyfunctional polymerization resin having a molecular weight Mn above 500,
>
> in which the quantitative ratios between the individual components

corresponding to an equivalent ratio of isocyanate groups of component b) to alcoholic hydroxyl groups of component a) of 0.5:1 to 5:1,

B) applying the mixture obtained in A) to a substrate and

C) reacting the isocyanate groups and hydroxyl groups to form said polyurethane coating.

OPINION

THE REFERENCE

The sole reference of record which is being relied on by the examiner as evidence of obviousness is:

Markusch et al. 5,372,875 December 13, 1994

Markusch et al. discloses an aqueous two-component polyurethane-forming composition containing a polyisocyanate and a polyhydroxyl compound (column 1, lines 12 through 16; column 2, lines 29 through 46). The aqueous composition contains one or more polyhydroxyl compounds which are either water soluble or water dispersible and, optionally, an emulsifier (column 5, line 30 through column 6, line 22). Useful polyhydroxyl compounds include polyesters (column 5,

lines 46 through 57) and have a molecular weight of from 400 to 10,000 (column 5, lines 58 through 65). Films of the dispersions so-prepared were coated on substrates and then cured (see Examples 3 through 6).

THE REJECTION

Claim 4 stands rejected under 35 U.S.C. § 103 in view of Markusch et al. as the subject matter claimed therein would have been obvious to a person of ordinary skill in the art at the time appellants' invention was made. We affirm.

Appellants' claim is of considerable scope. As a "comprising" claim, the claim is not limited to the ingredients

set forth therein but includes other disclosed but not claimed ingredients and even other ingredients neither disclosed nor claimed. Additionally, appellants have chosen to claim their invention by defining the various ingredients utilized in their process generically and in terms of the ingredients' respective molecular weights rather than claiming specific polyisocyanates and polyols.

In light of appellants' concession at page 3 of their

main brief that "Markusch et al teaches forming an aqueous dispersion by blending a polyisocyanate component and a polyol component with water, applying the unreacted mixture to a substrate and curing the coating by reacting the components", the narrow issue for us to decide, as framed by appellants, is whether Markusch et al. teach or fairly suggest component "a2)" of appellants' process. Appellants urge that Markusch et al.'s polyols are not "polymerization resins" and, therefore, Markusch et al. cannot render obvious, in the sense of the statute, the claimed invention. Appellants further argue that the claim terminology "polymerization resin" as defined in the specification is different from all Markusch et al.'s "polycondensation resins" described as useful polyols in Markusch et al.'s process. We disagree.

It is by now fundamental that pending claims in an application for patent are given their broadest, reasonable interpretation, in light of the teachings of the prior art and consistent with an applicant's disclosure as it would have been interpreted by a person of ordinary skill in the art. In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971); In re Prater, 415 F.2d 1393, 1404, 1405, 162 USPQ 541, 550,

551 (CCPA 1969) ("claims yet unpatented are to be given the broadest reasonable interpretation consistent with the specification *during examination of a patent application* since the applicant may then *amend* his claims, the thought being to reduce the possibility that, after the patent is granted, the claims may be interpreted as giving broader coverage than is justified" [footnote omitted]). However, the scope of a claim may not be narrowed by importing into the claim limitations from the specification, which have no express basis in the claim. Prater at 415 F.2d 1404, 162 USPQ 550.

In their main brief, appellants direct us to page 1, lines 3 through 6 of their specification and their original claims as support for their argument. Appellants' specification at page 1, lines 3 through 6 merely recites that the polyol may either be a high molecular weight polycondensation resin or a mixture of a polycondensation resin with a polymerization resin. Appellants' original claims included the same language now before us in describing components "a1)" and "a2)". Thus, neither the

specification nor the original claims shed any light on what

meaning appellants intended to convey by use of the claim terminology. There is scant little other guidance in the original disclosure concerning the meaning of the claim terminology.

Accordingly, while appellants declare that it is, thus, clear from the specification that polymerization resins could not include condensation resins, this is considered to be mere attorney argument unsupported by any evidence of record. While it is understood that an applicant for patent may be his own lexicographer, an applicant for patent may only be his own lexicographer where the definition applicant intends for a particular claim term, especially when that definition is different from the conventional, art-recognized definition, is clearly set forth in applicant's specification. Beachcombers, Int'l. v. WildWoode Creative Products, Inc., 31 F.3d 1154, 1156, 31 USPQ2d 1653, 1656 (Fed. Cir. 1994); ZMI Corp. v. Cardiac Resuscitator Corp., 844 F.2d 1576, 1579, 6 USPQ2d 1557, 1560 (Fed. Cir. 1988); Envirotech Corp. v. Al George, Inc., 730 F.2d 753, 759, 221 USPQ 473, 477 (Fed. Cir. 1984).

More importantly, we agree with the examiner's position that the broadest, reasonable interpretation of the claim term

"polymerization resin" is a resin prepared by any polymerization reaction, including condensation reactions. We take official notice of the fact that the term "polymerization" is understood to embrace both addition reactions involving free radicals and condensation reactions[2].

Finally, while the examiner has concluded that the "reference does not explicitly recite the addition of a mixture of two polyhydroxy resins" (see page 4 of the Answer), we note that Markusch et al. clearly describes that "one or more polyhydroxyl compounds" may be included in the aqueous dispersion used in their process (see column 5, lines 30 through 34). Accordingly, we find that Markusch et al. does suggest that mixtures of resins useful as the polyol component may be utilized. Because the examiner has established a *prima facie* case of obviousness which appellants have not rebutted, the decision of the examiner is affirmed.

OTHER ISSUES

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[2] See "The Condensed Chemical Dictionary", page 835, "polymerization", (1981). In re Ahlert, 424 F.2d 1088, 165 USPQ 418 (CCPA 1970).

In appellants' original claims the "a2)" component was originally claimed in terms of being present in a mixture with component "a1)" in an amount of "up to 100% by weight". This reflected appellants' disclosure from page 7, lines 16 and 17 and

page 10, lines 8 through 11 of the specification that component "a2)" was optional, that is, it need not be present. In the event of further prosecution of the subject matter of this application, the examiner and appellants should consider whether the newly added claim language "a positive amount to 100% by weight" is described, in the sense of 35 U.S.C. § 112, first paragraph, by appellants' original disclosure. The examiner and appellants should also investigate exactly what is intended by the phrase "a positive amount" since we find no disclosure in the specification defining said phrase.

As a related issue, the examiner and appellants should consider whether or not appellants' priority document, a translation of which was filed on October 16, 1995, satisfies the requirements of 35 U.S.C. § 112 inherent in 35 U.S.C. § 119. Benefit of prior applications under 35 U.S.C. § 119 for

determining the effective date of an application under 35 U.S.C. § 102(e) is accorded with respect to what is now claimed by an applicant. That is, under 35 U.S.C. § 119 the question to be resolved is: does an applicant's disclosure in the specification of the benefit application relied on satisfy the requirements of 35 U.S.C. § 112, first paragraph, with respect to the full scope of the subject matter now being claimed by applicant? See In re Gostelli, 872 F.2d 1008, 10 USPQ 2d 1614 (Fed. Cir. 1989): Kawai

v. Metlesics, 480 F.2d 880, 178 USPQ 158 (CCPA 1973). While the examiner has acknowledged receipt of the translation in Paper Number 13, there is no other discussion of the translation in the record. The examiner has an affirmative duty to analyze the translation for compliance with the statute.

In his Answer, the examiner has objected to claim 5 as dependent on a rejected claim and has further indicated that claim 5 would be allowable if rewritten in independent form. Nevertheless, the examiner and appellants should reconsider the indicated allowability of the subject matter of claim 5 in

light of the prior art of record which shows polyacrylate resins to be well known "hydroxyfunctional polymerization resins" useful in preparing *in situ* polyurethane coatings. See, for example, U.S. Patent Number 5,075,370 at column 3, lines 50 through 56.

SUMMARY

The decision of the examiner rejecting claim 4 under 35 U.S.C. § 103 is **AFFIRMED**.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED.

ANDREW H. METZ Administrative Patent Judge	))))))
CHUNG K. PAK Administrative Patent Judge	)BOARD OF PATENT) APPEALS AND)INTERFERENCES)))
THOMAS A. WALTZ Administrative Patent Judge	))

AHM/gjh

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